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No. 01-269

IN THE

Supreme Court of the United States

CREO PRODUCTS INC.,

Petitioner,

v.

DAINIPPON SCREEN MFG. CO., LTD., D.S. NORTH AMERICA HOLDINGS, INC., and DS AMERICA, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION FOR RESPONDENTS

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QUESTIONS PRESENTED

1. Whether Petitioner should be allowed to "piggyback" on this Court's grant of certiorari in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir 2000), even though the District Court's Order granting summary judgment of noninfringement challenged on appeal was issued eight months before *Festo*, was properly based on a straightforward application of the presumption established in this Court's unanimous decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), and does not involve any of the issues presented for review by this Court in *Festo*?

2. Whether Petitioner should be allowed to argue that so-called special "considerations of fairness" should be given to *pro se* patent applicants when Petitioner failed to raise the argument below and when doing so would fly in the face of the notice function of patent claims reaffirmed by this Court in *Warner-Jenkinson*?

CORPORATE DISCLOSURE STATEMENT

All parent corporations and publicly held companies that own 10 percent or more of the stock of Respondents are: Dainippon Screen Manufacturing Co., Ltd., D.S. North America Holdings, Inc., and DS America Inc.

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STATEMENT OF THE CASE

Petitioner Creo Products, Inc. ("Creo") and Respondent Dainippon Screen Manufacturing Co., Ltd. ("Screen")[1] are competitors in the market for digital prepress equipment used in the graphics art industry. While Screen and Creo once enjoyed a cordial business relationship, that changed in 1998 when Creo learned that Screen was going to directly compete with Creo in a new market utilizing the latest, high end thermal "computer-to-plate" technology. When Creo was unable to persuade Screen to abandon its plans to compete in this new market, Creo filed this action asserting multiple claims against Screen concerning technology Screen had used since the early 1990's, including a claim for infringement of U.S. Patent No. 4,743,091 (the " '091 patent"). The District Court resolved each of these claims in favor of Screen on summary judgment, awarded Screen attorney's fees,[2] and found that Creo's claim of infringement

1. In addition to Screen, two other entities, D.S. North America Holdings, Inc. and DS America Inc., are listed as "Respondents" in the Petition. The claims against those entities were dismissed for lack of personal jurisdiction (Fed. Cir. Jt. App. at A0362-74), and Creo did not challenge that ruling on appeal. Thus, Screen is the only Respondent directly affected by this appeal.

2. The District Court awarded Screen attorney's fees in connection with Creo's trade secret and literal infringement claims, finding that: (1) fees should be awarded based on Creo's pursuit of a claim for trade secret misappropriation that was "entirely specious" and asserted in "bad faith"; and (2) fees should be awarded under 35 U.S.C. § 285 based on Creo's pursuit of a claim for literal infringement that was "frivolous and wholly without merit." (Fed. Cir. Jt. App. at A0059, A0061.) The Federal Circuit affirmed. (Pet., App. A at 4a – 5a.) Creo now concedes in its Petition that Screen's products contain differences that are "sufficient to avoid

(Cont'd)

under the doctrine of equivalents "bordered on the frivolous." (Fed. Cir. Jt. App. at A0062.)

The relevant facts and procedural history relating to Creo's claim for infringement under the doctrine of equivalents — the only claim at issue in the Petition — are set forth below.

A. The Prosecution History Of The '091 Patent

The '091 patent has only one independent claim – claim 1. Each claim in the '091 patent includes an express limitation requiring that the system include a two-dimensional array of laser diodes "**mounted on a curved substrate**." As summarized in the District Court's Order granting summary judgment (Pet., App. B), this limitation did not appear in the original claims of the application, but was added – without any explanation in the file history – after a telephone interview in which the Examiner proposed, and the applicant (Mr. Gelbart) accepted and authorized, the additional amendment. (*Id.* at 17a - 19a.) Mr. Gelbart understood that adding the word "curved" to claim 1 limited the scope of his patent.[3]

(Cont'd)
the literal language of Creo's patent" (Pet. at 4), despite forcing Screen to incur substantial fees and costs in defending against this claim.

3. Mr. Gelbart testified:

> Q: You recognized that adding the word curved had an effect on the scope of the patent. Correct?
>
> A: Yes.

(Cont'd)

B. The District Court's Summary Judgment Ruling

Screen sought summary judgment of noninfringement below. With respect to literal infringement, Screen presented uncontested evidence that its accused products mounted the array on a **flat** substrate, not a **curved** substrate. With respect to infringement under the doctrine of equivalents, Screen relied upon the presumption established by this Court in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), in which the Court held that where no explanation for an amendment is established, it must be presumed that there was a substantial reason related to patentability for including the limitation, and no range of equivalents is available for the claim element as amended. *Id.* at 33-34. Screen did not contest, for the purposes of its summary judgment motion only, the factually intensive question of the equivalency of its accused products. (Pet., App. B at 15a, 17a.)

In response to Screen's summary judgment motion, Creo did not raise before the District Court the so-called "considerations of fairness" upon which its Petition is largely based. For example, Creo did not argue that the *Warner-Jenkinson* presumption should not apply because patent counsel did not represent Mr. Gelbart, or because the Examiner, rather than the applicant, proposed the amended language, as Creo now contends. Rather, Creo attempted to rebut the *Warner-Jenkinson* presumption by arguing that "[t]he record is *not* silent or ambiguous as to the reasons for

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(Cont'd)

Q: But you believed it was an acceptable limitation?

A. Correct.

Fed. Cir. Jt. App. at A1104.

the Examiner's Amendment of January 29, 1988." (Fed. Cir. Jt. App. at A1458 (emphasis added).) Creo contended that the Examiner's Amendment was "clearly made for the purposes of avoiding ambiguity and indefiniteness," and not for reasons related to patentability. (*Id.* at A1454, A1456.) Creo argued that "Screen's contention that no reason is given in the record for the Examiner's Amendment of January 29, 1988 is disingenuous." (*Id.* at A1458.)

On March 24, 2000 – over eight months before the Federal Circuit issued its *en banc* opinion in *Festo* – the District Court, in a thorough and well-reasoned decision, granted summary judgment to Screen on Creo's patent infringement claim. (Pet., App. B.) In analyzing the applicability of the *Warner-Jenkinson* presumption, the District Court – relying on *Warner-Jenkinson* and *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817 (Fed. Cir. 1999)[4] – found that (1) the *Warner-Jenkinson* presumption applied because the prosecution history failed to indicate the reason for the amendment which added the "mounted on a curved substrate" limitation; and (2) Creo failed to rebut the presumption, resulting in a complete bar to any range of equivalents as to that limitation. The District Court rejected Creo's contentions that the amendment was

4. In *Sextant*, the Federal Circuit recognized that where the *Warner-Jenkinson* presumption applies, "prosecution history estoppel would bar the application of the doctrine of equivalents as to that element." *Sextant*, 172 F.3d at 831 (quoting *Warner-Jenkinson*, 520 U.S. at 33). Creo claims that *Sextant* provides for a "harsh, rigid bright line rule" that led the District Court into error (Pet. at 2 n.1), when in fact *Sextant*'s holding does nothing more than quote *Warner-Jenkinson* for the uncontroversial proposition – conceded by Creo before the Federal Circuit – that when the *Warner-Jenkinson* presumption applies and is not rebutted, no range of equivalents is available.

not related to patentability and was to address indefiniteness concerns. (Pet., App. B at 20a – 24a .)[5] Accordingly, the District Court found that Screen's products could not meet the "mounted on a curved substrate" limitation under the doctrine of equivalents as a matter of law. (*Id.* at 17a, 24a.)

The District Court's finding is amply supported by the record. There is no statement, reference or indication anywhere in the prosecution history of the reason for Creo's "mounted on a curved substrate" amendment. (*See* Fed. Cir. Jt. App. at A1624-25, A1110-58.) The claim language "a two-dimensional array of laser diodes mounted on a curved substrate" was substituted into the patent by an Examiner's Amendment apparently prepared on January 29, 1988. (*Id.* at A1150-51.) The Examiner's Amendment states that "[a]uthorization for this Examiner's Amendment was given in a telephonic interview with Mr. Gelbart on January 29, 1988." (*Id.*) The PTO file contains a form, identified as PTOL-413, entitled "Examiner's Interview Summary

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5. The District Court noted in response to Creo's doctrine of equivalents argument:

> Creo fails . . . to respond adequately to the main point of [Screen's] motion, i.e., the doctrine of equivalents does not, as a matter of law, apply here. For purposes of this motion, Screen *concedes* that its products contain a structure equivalent to the curved substrate limitation. Screen argues that the court should not employ the doctrine of equivalents at all because Creo is barred from arguing such equivalency by prosecution history estoppel.

Pet., App. B at 15a (emphasis in original). Contrary to Creo's suggestion (Pet. at 12), Screen never conceded it was a "copyist," nor did the District Court or Federal Circuit so find.

Record" dated January 29, 1988. (*Id.* at A1150.) Neither this form nor anything else in the prosecution history indicates the reason for the amendment. Because "the record seems not to reveal the reason" for the amendment (*Warner-Jenkinson*, 520 U.S. at 33), the District Court correctly found the presumption applied. *Id.* at 33-34.

C. Proceedings Before The Federal Circuit

Creo's Opening Brief on appeal contended that the *Warner-Jenkinson* presumption should not apply, making a new argument not presented to the District Court below: that the presumption should not apply because the relevant change in claim language was required by **Examiner**, as opposed to the **applicant**. (OB, 26, 30-35.) Creo conceded that if the presumption did apply, however, it would not be entitled to any range of equivalents for the amended claim limitation under *Warner-Jenkinson*. (OB, 34.)

Notwithstanding the issuance of *Festo* shortly after Creo filed its Opening Brief, Screen's Appellees' Brief argued primarily that the District Court had properly applied the *Warner-Jenkinson* presumption, citing *Warner-Jenkinson* and *Sextant*, as well as *Festo* to the extent it reaffirmed the *Warner-Jenkinson* presumption. (AB, 21-27.) Screen further noted that, even assuming that the presumption did not apply (which it clearly did), *Festo*'s "complete bar" would provide an alternate basis for affirming the District Court's Order. (*Id.* at 28.) In its Reply Brief, Creo abandoned its patent infringement claim, stating that "in view of [the Federal Circuit's] recent holding in *Festo*, Creo will confine its arguments principally to non-patent aspects of its claims." (RB, 3.)

In an unpublished, five page *per curiam* decision dated May 14, 2001, the Federal Circuit affirmed the District Court's order granting summary judgment on all claims for relief. (Pet., App. A.) The Federal Circuit addressed the issue of infringement under the doctrine of equivalents in one paragraph, finding that no range of equivalents was available to Creo and affirming the District Court. (Pet., App. A at 4a.) In so holding, the Federal Circuit referenced its decisions in *Sextant* and *Festo*, both of which followed this Court's unanimous opinion in *Warner-Jenkinson* in holding that where no explanation for an amendment is established, it must be presumed that there was a substantial reason related to patentability for including the limitation and no range of equivalents is available for the claim element as amended. *Sextant*, 172 F.3d at 828; *Festo*, 234 F.3d at 578. Creo's Petition followed.

REASONS FOR DENYING THE PETITION

The Petition is not deserving of review, nor is this case deserving of remand for further proceedings consistent with this Court's forthcoming decision in *Festo*. First, a remand or even a reversal in *Festo* would not provide any legal basis for disturbing the District Court's Order in this case, which was decided before *Festo* and rests squarely upon the *Warner-Jenkinson* presumption. Although the Federal Circuit's *Festo* opinion did reaffirm unanimously the *Warner-Jenkinson* presumption, that portion of the opinion has not been presented for review in the *Festo* appeal. The Court's decision in *Festo* will therefore have no impact on this case.

Second, this case presents a poor vehicle for this Court to reach and resolve so-called "considerations of fairness" in connection with the doctrine of equivalents. Not only is

the *Warner-Jenkinson* presumption clearly applicable to this case, but such considerations should not be addressed in connection with this case because Creo failed to raise them below and, therefore, the record below is almost entirely devoid of support for such considerations. Even if they were addressed, allowing the factors set forth in the Petition to trump the *Warner-Jenkinson* presumption would fly in the face of the notice function of patent claims reaffirmed by this Court in *Warner-Jenkinson* and would thereby undermine over 100 years of Supreme Court precedent.

A. The District Court's Order Was Decided Before *Festo* And Depended Solely On The *Warner-Jenkinson* Presumption. This Court's Resolution Of *Festo* Will Not Affect Resolution Of This Case.

In *Warner-Jenkinson*, this Court addressed the problem where, as here, the prosecution record seems not to reveal the reason for including a claim element by amendment. 520 U.S. at 33. The Court held:

> In our view, holding that certain reasons for a claim amendment may avoid the application of prosecution history estoppel is not tantamount to holding that the *absence* of a reason for an amendment may similarly avoid such an estoppel. **Mindful that claims do indeed serve both a definitional and a notice function, we think the better rule is to place the burden on the patent holder to establish the reason for an amendment required during patent prosecution**. . . Where no explanation is established . . . the court should presume that the patent applicant had a substantial reason related

> to patentability for including the limiting element added by amendment. In those circumstances, prosecution history estoppel would bar the application of the doctrine of equivalents as to that element. The presumption we have described, one subject to rebuttal if an appropriate reason for a required amendment is established, **gives proper deference to the role of claims in defining an invention and providing public notice**, and to the primacy of the PTO in ensuring that the claims allowed cover only subject matter that is properly patentable in a proffered patent application. Applied in this fashion, prosecution history estoppel places reasonable limits on the doctrine of equivalents, and further insulates the doctrine from any feared conflict with the Patent Act.

Id. at 33-34 (emphasis in original; bold added). As set forth in the highlighted language above, the public notice function of patent claims was a paramount concern in *Warner-Jenkinson*, as well as this Court's other opinions addressing the doctrine of equivalents and prosecution history estoppel. *See, e.g., Warner-Jenkinson*, 520 U.S. at 29 ("There can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice function of the statutory claiming requirement); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 221 (1940) ("The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest."). As the District Court noted, the *Warner-Jenkinson* presumption is warranted:

> due to the public notice function of the Patent Act, i.e., future inventors should be able to assess with reasonable certainty both the literal scope of the patent claims and the effective extension of the claim scope under the doctrine of equivalents. Through operation of the *Warner-Jenkinson* presumption, the burden is on the patentee to clarify his reasons. The public, and future inventors, should not suffer from an uncertain range of equivalency in a claim due to the patentee's failure to clarify the reasons for an amendment.

Pet., App. B at 16a – 17a (citations omitted).

1. The District Court's Order Was Based On The *Warner-Jenkinson* Presumption, Not *Festo*

As Creo fails to inform the Court, the District Court granted summary judgment of noninfringement under the doctrine of equivalents because of *Warner-Jenkinson*, not any new "bright line test" established by *Festo*. Following *Warner-Jenkinson*, the District Court engaged in a careful factual review of Creo's efforts to rebut the *Warner-Jenkinson* presumption and ultimately found the presumption applied. (*Id.* at 19a - 24a.) As noted, on appeal, Creo dropped its rebuttal argument and all but abandoned its patent infringement claim. In its summary affirmance, the Federal Circuit gave no indication that it was imposing a "bright line test" (as Creo repeatedly contends), but instead simply affirmed the District Court's Order, noting that *Sextant* and *Festo* "preclude application of the doctrine of equivalents under the facts of this case, and we therefore affirm that aspect of the district court's judgment." (Pet., App. A at 4a.)

Given that the District Court's Order is based squarely on this Court's unanimous opinion in *Warner-Jenkinson* and was decided months before *Festo*, Creo's attempt to obtain a remand of this action in light of the Court's grant of certiorari in *Festo* should be rejected. Indeed, Creo purports to rely upon *Warner-Jenkinson* as the basis for its Petition, but fails to even mention that the District Court's grant of summary judgment to Screen was actually based on *Warner-Jenkinson*. *See, e.g.*, Pet. at 2 n.1, 5 (stating that District Court's decision based only on *Sextant*).

2. Neither The Questions Presented In The Petition Nor This Court's Forthcoming Decision In *Festo* Contemplate Overturning The *Warner-Jenkinson* Presumption

Although Creo clearly could not prevail on appeal unless this Court overrules (or severely limits) *Warner-Jenkinson*, the Questions Presented in the Petition do not encompass disturbing *Warner-Jenkinson* in any way. It is well-settled that "[o]nly the questions set forth in the petition, or fairly included therein, will be considered by the Court." Rule 14.1(a); *Yee v. City of Escondido*, 503 U.S. 519, 535 (1992). The Court should therefore deny the Petition.

Further, remand in light of *Festo* would be inappropriate because the questions to be addressed by the grant of certiorari in *Festo* do not contemplate any challenge to the *Warner-Jenkinson* presumption. The Federal Circuit in *Festo* addressed five separate questions, and the Federal Circuit's holding with respect to question four – in which the Federal Circuit unanimously reaffirmed the *Warner-Jenkinson*

presumption as well as the Federal Circuit's decision in *Sextant*[6] – is not at issue in this Court's grant of certiorari in *Festo*.[7] Remand of this case is therefore not appropriate.

Indeed, Creo is simply wrong when it contends that there is a "conflict" between how this case would be resolved under *Warner-Jenkinson* and *Festo*. (Pet. at 2.) Under either case, an unexplained amendment required during prosecution such as the amendment at issue here results in a bar to the doctrine of equivalents. Remand is therefore not appropriate. *See Lawrence v. Chater*, 516 U.S. 163, 167-68 (1996) (remand appropriate only if "reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration.")

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6. Question four in *Festo* was as follows: "When 'no explanation [for a claim amendment] is established,' thus invoking the presumption of prosecution history estoppel under *Warner-Jenkinson*, what range of equivalents, if any, is available under the doctrine of equivalents for the claim element so amended?" 234 F.3d at 578 (quoting *Warner-Jenkinson*, 520 U.S. at 33). The Federal Circuit answered unanimously that "[w]hen no explanation for a claim amendment is established, no range of equivalents is available for the claim element so amended." 234 F.3d at 578.

7. The "Questions Presented" in *Festo*'s Petition for Writ of Certiorari (dated April 9, 2001) address only *Festo*'s questions one and three. Specifically, the *Festo* Petition asked "[w]hether every claim-narrowing amendment designed to comply with any provision of the Patent Act – including those provisions not related to prior art – automatically creates prosecution history estoppel regardless of the reason for the amendment"; and "[w]hether the finding of prosecution history estoppel completely bars the application of the doctrine of equivalents." Neither question contemplates challenging the *Warner-Jenkinson* presumption.

That the Federal Circuit's opinion affirming the District Court happens to cite *Festo* along with pre-*Festo* authority (*Sextant*) should not provide Creo with an opportunity to delay final resolution of this action, particularly given that the District Court's Order does not even cite *Festo*, as it was issued months *before* that opinion was issued. The Federal Circuit most likely cited *Festo* for its uncontroversial and unanimous recognition that the *Warner-Jenkinson* presumption, when applicable, bars application of the doctrine of equivalents – the same proposition for which the Federal Circuit cited *Sextant* and which was conceded by Creo below.

B. So-Called "Considerations Of Fairness" Should Not Be Reached, As They Were Not Raised Below And Therefore Do Not Present An Adequately Developed Record For Adjudication. In Any Event, The Factors Set Forth In The Petition Must Yield To The Public Notice Function Of Patent Claims.

Even if the Court were inclined to review so-called "considerations of fairness," this case is a poor vehicle to do so for several reasons.

1. Creo Failed To Raise Purported "Considerations Of Fairness" Below.

The Petition seeks this Court's review of the role of purported "considerations of fairness" in the doctrine of equivalents analysis. This case presents a particularly poor vehicle for the Court to address such novel considerations, even if they had any vitality.

First, because review of the arguments presented below would confirm that the *Warner-Jenkinson* presumption applies here, the Court would have no need to reach the "consideration of fairness" Creo addresses.

More fundamentally, though Creo was well aware that *Warner-Jenkinson* was the basis of Screen's summary judgment motion, Creo failed to raise below virtually every one of the "considerations" referenced in the Petition. As a result, most of the "considerations" are not supported by any evidence in the record.[8]

Rather than arguing to the District Court the considerations set forth in the Petition, Creo attempted to rebut the *Warner-Jenkinson* presumption by arguing that "[t]he record is not silent or ambiguous as to the reasons for the Examiner's Amendment of January 29, 1988" and that "Screen's contention that no reason is given in the record for the Examiner's Amendment of January 29, 1988 is disingenuous." (Fed. Cir. Jt. App. at A1458.)

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8. For example, the record is devoid of support concerning (1) whether Creo's inventor, Mr. Gelbart, had limited funds and whether a lack of funds contributed to Mr. Gelbart's decision to prosecute the patent-in-suit *pro se*; (2) whether Mr. Gelbart lacked experience in drafting claims and prosecuting patents; (3) whether Mr. Gelbart's purported inexperience was the cause of rejections by the Examiner; (4) whether the Examiner "perhaps recogniz[ed]" Mr. Gelbart's inexperience in offering suggestions as to how the claims could be amended; (5) whether Mr. Gelbart, in prosecuting the application, acted with the assistance or advice of any counsel; (6) whether Mr. Gelbart speaks English as a second language; and (7) whether Mr. Gelbart trusted a recommendation made by the Examiner for amending his application.

Creo should not now be allowed to argue a completely different theory before this Court. This Court should adhere to its well-established practice of declining to consider issues not clearly raised or addressed below. *See Singleton v. Wulff*, 428 U.S. 106, 120 (1976). This practice is "essential in order that parties may have the opportunity to offer all the evidence they believe relevant to the issues . . . [and] in order that litigants may not be surprised on appeal by final decision there of issues upon which they have had no opportunity to introduce evidence." *Hormel v. Helvering*, 312 U.S. 552, 556 (1941).[9] It applies with particular force to review of summary judgment orders, which should be limited to materials before the District Court. *See, e.g., Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 157 n.16 (1970) (in reviewing grant of summary judgment, statement not in proceedings below cannot be properly considered for first time on appeal); 10A C. Wright, A. Miller & M. Kane, *Federal Practice and*

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9. Creo distorts the procedural history and state of the record below when stating that the Federal Circuit "declined to consider any mitigating factors and reached its result without regard for whether the result was fair, equitable or consistent with the constitutional purpose of the patent system." (Pet. at 6.) As set forth above, most of the purported "fairness" factors pressed by Creo in its Petition were never raised below in either the District Court or the Federal Circuit. Unsupported by anything in the record, the Federal Circuit therefore could not have properly considered such factors even if it wanted to address an issue not raised below for the first time on appeal. Further, Creo's contention that its attempt to draw a distinction between "unexplained amendments" made by the Examiner as opposed to the applicant was "side-stepped" by the Federal Circuit (Pet. at 13) is also inaccurate. Creo did not raise this issue in the District Court, and simply abandoned the issue in its Reply Brief in the Federal Circuit. *See* RB at 3 ("in view of [the Federal Circuit's] recent holding in *Festo*, Creo will confine its arguments principally to the non-patent aspects of its claims.")

Procedure § 2716, at 282-86 (3d ed. 1998) (court reviewing summary judgment order "can consider only those papers that were before the trial court. The parties cannot add exhibits, depositions, or affidavits to support their position. *Nor can they advance new theories or raise new issues in order to secure a reversal of the lower court's determination.*") (emphasis added) (footnotes omitted).

2. Purported "Considerations Of Fairness" Cannot Trump The Notice Function Of Patent Claims.

Even if properly raised and supported by the record, there is no reason that Creo's so-called "considerations of fairness" should require an exception to the *Warner-Jenkinson* presumption. First, Creo is in error in contending that an amendment is "explained" for purposes of the *Warner-Jenkinson* presumption simply because the Examiner made the amendment. (Pet. at 13-14.) Given the public notice function of patent claims noted above, the critical question for purposes of the *Warner-Jenkinson* presumption is whether the prosecution history reveals **why** the amendment was suggested, not **who** suggested it. *Warner-Jenkinson* clearly encompasses situations where, as here, the Examiner required the change. 520 U.S. at 33 (referring to "an amendment *required* during patent prosecution") (emphasis added). *See also Mycogen Plant Science, Inc. v. Monsanto Co.*, __ F.3d __, 2001 WL 910389 (Fed. Cir. Aug. 14, 2001) (where applicant acquiesced in Examiner's proposal to limit claim language, "it is appropriate to limit [applicant] to the literal scope of the claims to which it agreed"); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1369-70 (Fed. Cir. 1999) ("[t]he fact that the words were formally entered by the Examiner (after conversations with the applicant) rather than the applicant *does not affect the question of whether a*

substantial reason related to patentability precipitated their addition.") (emphasis added). Indeed, Creo's contention that simply because the Examiner formally entered the amendment (with the applicant's express consent), the applicant should be entitled to immunity from prosecution history estoppel, ignores over 100 years of Supreme Court precedent.[10]

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10. *See Graham v. John Deere Co.*, 383 U.S. 1, 34 (1966) ("the patentee obtained his patent only by accepting the limitations imposed by the Examiner. The claims were carefully drafted to reflect these limitations and Cook Chemical is not now free to assert a broader view of Scoggin's invention."); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 221-22 (1940) ("the patentee, having acquiesced in the rejection, is no longer free to gain the supposed advantage of the rejected claims by a construction of the allowed claims as equivalent to them."); *Smith v. Magic City Kennel Club, Inc.*, 282 U.S. 784, 789 (1931) ("where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent."); *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U.S. 425, 429 (1894) ("the patentee having once presented his claim in that form and the patent office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim or such a construction of his present claim as would be equivalent thereto."); *Crawford v. Heysinger*, 123 U.S. 589, 606-07 (1887) ("The patentee having imposed words of limitation upon himself in his claims, especially when so required by the patent-office in taking out his reissue, is bound by such limitations, in subsequent suits on the reissued patent. Such have been the uniform decisions of this court in like cases."); *Sutter v. Robinson*, 119 U.S. 530, 541(1886) (patentee "is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant.").

Second, many of the types of "considerations" Creo raises are not disclosed in the '091 patent's file wrapper, nor would they typically be disclosed in file wrappers of other patents. For example, there would be no way for a competitor examining the file wrapper to determine whether the applicant had limited funds, whether the applicant was prosecuting the application without the assistance of a lawyer, whether English was the applicant's second language, etc. To create an exception to the *Warner-Jenkinson* presumption based on such "considerations of fairness" not found in the prosecution history would fly in the face of the public notice function of patent claims discussed in *Warner-Jenkinson*. It would also likely encourage applicants to try to take advantage of such an exception and avoid the *Warner-Jenkinson* presumption and prosecution history estoppel by, for example, deciding to prosecute patent applications *pro se*. This is not, and cannot, be the law.

Third, this Court has repeatedly held that the types of litigation-inspired speculation set forth in the Petition as to the Examiner's and the applicant's motives in prosecuting a patent are improper. *See Warner-Jenkinson*, 520 U.S. at 33 n.7 (courts should not inquire into correctness of Examiner's objection that led to claim amendment; "such concerns are properly addressed on direct appeal from the denial of a patent, and will not be revisited in an infringement action"); *Hubbell v. United States*, 179 U.S. 77, 83-84 (1900) (courts should not speculate as to whether amendment material to prosecution of patent; "all must be regarded as material").

Finally and perhaps most importantly, Creo's suggestion that estoppel principles should not apply here because there was no "act of commission or omission by the person to be estopped" (Pet. at 13) completely ignores the facts that

(1) Mr. Gelbart himself authorized and accepted the amendment; and (2) he understood that adding the word "curved" to claim 1 limited the scope of his patent. *See* note 3 *supra*. Accordingly, the only unfairness that could result here would be to allow Mr. Gelbart's clear and unmistakable acceptance and authorization of the amendment to cause further delay in final resolution of this action.

CONCLUSION

For the foregoing reasons, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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